APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,962	04/07/2000	James Shanahan	D/99458	2107

			EXAMINER
7590	01/11/2006		NGUYEN, MAIKHANH

John E Beck
Xerox Corporation
Xerox Square 20A
Rochester, NY 14644

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/543,962	SHANAHAN ET AL.
Office Action Summary	Examiner	Art Unit	
	Maikhanh Nguyen	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _21 October 2005_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-37_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-37_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: RCE filed 10/21/2005 to the original

application filed 04/07/2000.

2.   Claims 1-37 are currently pending in this application. Claims 1-2, 19-20, and 28-29 have

been amended. Claims 1, 19, and 28 are independent claims.

Request Continuation for Examination

3.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR

1.17(e) has been timely paid, the finality of the previous Office action has been

withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/2005 has

been entered.

Specification

4.   The cross reference related to the application cited in the specification must be updated

(i.e., update the relevant status, with PTO serial numbers or patent numbers where

appropriate, on page 1). Correction is required.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> *The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

6.   Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to independent claims 1, 19, and 28, the claimed *context ("personality")* renders the claims indefinite because it is unclear if *context* is the same as *"personality"*.

As to independent claim 1, the limitation *"a service provider"*, recited at lines 13-15, is vague and indefinite. It is unclear if the limitation is referring to "a service provider" recited at line 6.

As to independent claim 19, the limitation *"a service provider"*, recited at line 16, is vague and indefinite. It is unclear if the limitation is referring to "a service provider" recited at line 6.

As to independent claim 28, the limitation *"a service provider"*, recited at lines 12-13, is vague and indefinite. It is unclear if the limitation is referring to "a service provider" recited at line 6.

Dependent claims 2-18, 20-27 and 29-37 are rejected for fully incorporating the deficiencies of their base claims.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8.   The language of claims 1-37 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

9.   Independent claims 1, 19, and 28 do not appear to require any computer hardware to implement the claimed invention. These claims appear to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of claim. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. In re Schrader, 22 F.3d 290 at 294-95, 30 USPQ2d 1455 at 1458-59 (Fed. Cir. 1994). Transformation of data by a machine constitutes

statutory subject matter if the claimed invention as a whole accomplishes a practical

application. That is, it must produce a "useful, concrete and tangible result." State Street,

149 F.3d 1368, 1373, 47 USPQ2d 1596 at 1600-02 (Fed. Cir. 1998). MPEP 2106. State

Street required transformation of data by a machine before it applied the "useful,

concrete, and tangible test." However, State Street does not hold that a "useful, concrete

and tangible result" alone, without a machine, is sufficient for statutory subject matter.

State Street, 149 F.3d at 1373, 47 USPQ2d at 1601.

10.   Claims 19-37 are rejected under 35 U.S.C. 101 because the claimed invention, appearing

to be comprised of software alone without claiming associated computer hardware

required for execution, is not supported by either a specific and substantial asserted utility

(i.e., transformation of data) or a well established utility (i.e., a practical application).

11.   Claims 1-18 do not appear to require any computer hardware to implement the claimed

invention. These claims appear to define the metes and bounds of an invention comprised

of software alone. There is no support (i.e., explicitly claimed computer hardware) in the

body of claims 1-18 to support the "system" of the preamble. Likewise, the "system" of

the preamble of claims 1-18 appears to be a system comprised entirely of software.

Software alone, without a machine, is incapable of transforming any physical subject

matter by chemical, electrical, or mechanical acts.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13.   Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barrera et al.** (U.S. 6,567,800 – filed 03/2000) in view of **Doyle** (U.S. 6,510,432).

As to claim 19

a.   Barrera teaches a document-centric method for acquiring information pertaining

to a document, the document including content information *(see the Abstract)*,

comprising:

(i)   creating a meta-document *(e.g., Website content; see fig.1)*, comprising

providing the document, associating a set of pre-packaged document

service requests based on a theme or context 'personality' *(e.g., a category*

is Arts&Humanities, 101, which has subcategories Literature 102 and

Photography 103; col.1, lines 49-56 and fig.1)associated with the

document, wherein a document service comprises a process for using a

portion of the document's content information as a starting point to obtain

other information from a service provider pertaining to the document's

content information (e.g., *"Arts&Humanities" category is used in fig.1 as*

a starting point to obtain the information shown in fig.2), wherein

associating a set of document service requests based on different

personality to the document content information will provided different

results *(see figs. 1-2 and the associated text)*;

(ii)   autonomously acting and managing the document service requests without

user intervention *(website content is automatically gathered and stored;*

col.4, lines 4-15), comprising:

-    selecting a document service request from the set *(e.g., selects the*

"Literature" from "Arts&Humanities"; see fig.1);

-    analyzing the document for the document content information

contained within the document exploited by the selected document

service to obtain other information from a service provider *(e.g.,*

Authors, Awards etc., are obtained from Literature) pertaining to

the document's content information *(see fig.2 and the associated*

text);

-    initiating and managing communication with the service provider

to satisfy the selected document service request using the analyzed

document content information *(e.g., a dynamically generated web*

page ...tailored to response to the query; col.5, lines 11-16); and

-        integrating any results from the selected document service request

         into the meta-document *(e.g., combine the best aspects of category*

         searching and content searching of websites in a way that enables

         a user to more accurately and complete identify websites with

         content of interest to the user, especially in a large collection of

         websites; col.3, lines 45-50 /the results of the search are displayed

         to the user ... as a dynamically generated web page; col.5, lines

         11-16 and see fig.10), wherein the meta-document includes the

         document, the set of document service requests and integrated

         results *(e.g., when user selects "Authors", a document including*

         35 authors will be retrieved and displayed; see fig.2 and the

         associated text).

b.   Barrera teaches the meta-document for document service requests. Barrera,

      however, does not specifically teach *"periodically polling."*

c.   Doyle teaches periodically polling (e.g., *such gathering is provided by an*

      automated process where searches on the web are periodically carried out to

      locate information on a user specified topic and that information retrieved and

      stored in a database so that the content is accessible independent of the status of

      the content on the web; col.4, lines 14-23 / col.7, lines 50-60 / col.8, line 54-col.9,

      line 3 & col.10, lines 64-67).

d.   It would have been obvious to one of ordinary skill in the art at the time of the

      invention was made to include the feature from Doyle in the system of Barrera

because it would have provided the capability for defining how often the search

and archive agent will search the data sources accessible through the network for

information content on the topic.

As to claim 20

Barrera teaches the personality is, among other things, Generic *(see fig. 1)*.

As to claim 21

Barrera teaches the results from the selected document service include a new document

service request associated with the document *(e.g., The results of this category-content*

search are sent to the user; col.4, lines 54-65 and fig.6/ The results of the search are

displayed to the user ... 'dynamically generated web page' means a web page that

includes content specifically tailored to response to the user query; col.5, lines 11-16 and

fig.10/ combination of category and content search provided ... produces website search

result; col.5, lines 60-65).

As to claim 22

Barrera teaches the document services are satisfied by a third party service provider via

an Internet protocol *(col.2, lines 25-34; col.4, lines 4-15 and fig.5)*.

As to claim 23

a.   Barrera does not specifically teach *"the scheduler updates the set of document*

        service requests on a predetermined schedule."

b.   Barrera teaches the scheduler updates the set of document service requests on a

        predetermined schedule *(col.7, lines 50-60)*.

c.   It would have been obvious to one of ordinary skill in the art at the time of the
invention was made to include the feature from Doyle in the system of Barrera
because it would have provided the capability for defining how often the search
and archive agent will search the data sources accessible through the network for
information content on the topic.

As to claim 24

a.   Barrera does not specifically teach *"the scheduler re-initiates selected document
service request on a periodic basis."*

b.   Doyle teaches the scheduler re-initiates selected document service request on a
periodic basis *(e.g., such gathering is provided by an automated process where
searches on the web are periodically carried out to locate information on a user
specified topic and that information retrieved and stored in a database so that the
content is accessible independent of the status of the content on the web; col.4,
lines 14-23).*

c.   It would have been obvious to one of ordinary skill in the art at the time of the
invention was made to include the feature from Doyle in the system of Barrera
because it would have provided the capability for defining how often the search
and archive agent will search the data sources accessible through the network for
information content on the topic.

As to claim 25

a.   Barrera does not specifically teach *"the periodic basis is determined by the
selected document service request."*

b.   Doyle teaches the periodic basis is determined by the selected document service

request *(e.g., the periodicity defines how often the search and archive agent will*

search the data source ... the periodicity may be hourly ...the topic is currently

event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-

60 & col.8, line 54-col.9, line 4).

c.   It would have been obvious to one of ordinary skill in the art at the time of the

invention was made to include the feature from Doyle in the system of Barrera

because it would have provided the capability for defining how often the search

and archive agent will search the data sources accessible through the network for

information content on the topic.

As to claim 26

Barrera teaches the set of document service s follow a predetermined sequence of calls to

service providers for extracting information from other documents, databases and data

stores *(col.3, lines 60-67)* and for searching, for other information responsive to any

extracted information from the other documents, databases and data stores *(col.4, lines*

54-65).

As to claim 27

a.   Barrera teaches the pre-determined sequence of calls to service providers are

satisfiable asynchronously.

b.   Doyle teaches the pre-determined sequence of calls to service providers are

satisfiable asynchronously *(col.8, lines 1-22).*

c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to claim 1

a. It is directed to a system for performing the method of claim 19, and is similarly rejected under the same rationale. Additionally, claim 1 further recites "a scheduler".

b. Doyle teaches a scheduler (e.g., *the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ...the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60).*

c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to claims 2-4

They include the same limitations as in claims 20-22, and are similarly rejected under the same rationale.

As to claims 5-7

They include the same limitations as in claim **23-25**, and are similarly rejected under the same rationale.

As to claim 8

a.   Barrera does not explicitly teach "*the meta-document, the scheduler and the service providers reside at the same location.*"

b.   Doyle teaches the meta-document, the scheduler and the service providers reside at the same location *(col.1, line 41- col.2, line 3 and col. 9, lines 50-60)*.

c.   It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to claim 9

a.   Barrera does not explicitly teach "*the meta-document, the scheduler and the service providers reside at the same location.*"

b.   Doyle teaches the meta-document, the scheduler and the service providers reside at different locations *(col.4, lines 40-62 and col.14, lines 24-31)*.

c.   It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to claims 10-11

They include the same limitations as in claims **26-27**, and are similarly rejected under the same rationale.

As to claim 12

Barrera teaches the document and the set of document service requests are user-selectable *(col.4, lines 54-65 and fig.1).*

As to claim 13

a.   Barrera teaches a user may select a document service request from the set and initiate and manage communication with a service provider to satisfy the selected document service, but does not specifically teach "the scheduler".

b.   Doyle teaches the scheduler *(e.g., the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ...the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60).*

c.   It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to claim 14

Barrera teaches a list of document service requests from which the set of document

service requests may be selected by a *user (e.g., searching all of the content of the*

universe of websites initially; col.2, lines 56-67 and fig.1).

As to claim 15

Barrera teaches the service provider is user-selectable *(e.g., searching all of the content of*

the universe of websites initially; col.2, lines 56-67 and fig.1).

As to claim 16

Barrera teaches a service provider can register additional document services to the list

(e.g., Registered Sites List; fig.7).

As to claim 17:

Barrera teaches a list of service providers available for satisfying document services

(col.4, lines 4-34).

As to claim 18

Barrera teaches the set of document service requests associated with the document are

associated using metadata *(col.5, lines 43-46).*

As to claim 28

a.   The rejection of independent claim 19 above is incorporated herein in full.

        Additionally, claim 28 further recites "a document including content

        information".

b.   Barrera teaches a document including content information *(e.g., website content;*

        col.4, lines 4-7).

As to claims 29-34, 35-36 and 37

They include the same limitations as in claims 2-7, 10-11 and 18, and are similarly

rejected under the same rationale.

Response to Arguments

14.   Applicant's arguments filed 10/21/2005 have been fully considered but they are not

persuasive.

Applicant argues that *in Barrera et al., the user must input a topic to be searched. In*

Applicant's system and method, each document service analyzes the document for

document content information to be exploited by the document service to obtain other

information from a service provider pertaining to the document's content information

(Remarks, page 10).

In response, Applicant is arguing the disclosure, not the claim limitations. The limitation

"*each document service analyzes the document for document content information to be*

exploited by the document service to obtain other information from a service provider

pertaining to the document's content information" is not claimed. Claimed subject

matter, not the specification is the measure of the invention. Limitations in the

specification cannot be read into the claims for the purpose of avoiding the prior art. See

In re Self, 213 USPQ 1,5 (CCPA 1982); In re Priest, 199 USPQ 11, 15 (CCPA 1978).

The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the

claims *as broadly as reasonably possible* during prosecution (see *In re Prater, 56 CCPA
1381, 415 F.2d 1393, 162 USPQ 541 (1969))*.

Applicant argues that *Barrera does not teach a "personality."* (Remarks, page 10).

In response, it is noted that independent claims 1, 19, and 28 require *a theme* <u>or</u> *context
("personality"),* not both. Barrera teaches a theme (e.g., Literature, Photography...) and

personality (e.g., *Arts* for people who interest in Arts or *Computers & Internet* for people

who interest in computers and Internet [see fig.1].

Conclusion

15.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

-      Peckover   U.S. Patent No. 6,119,101   issued: Sep. 12, 2000

-      Srivastava et al.   U.S. Publication 2002/0120685 A1 Pub. Date: Aug. 29, 2002

-      Meltzer et al.   U.S. Publication 2002/0165872 A1 Pub. Date: Nov. 7, 2002

-      Dourish et. al., "Extending Document Managment System with User-Specific

Active Properties", ACM Transactions on Information System, Vol. 18, No. 2, April

2000, pp. 140-170.

- Dourish et. al., "Using Properties for Uniform Interaction in the Presto Document System", Proceedings of the 12th Annual ACM Symposium on User Interface Software and Technology, November 1999, pp. 55-64.

- Dourish et. al., "A Programming Model for Active Document", Proceedings of the 12th Annual ACM Symposium on User Interface Software and Technology, Vol.2, November 2000, pp. 41-50.

Contact information

16.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN

WILLIAM BASHORE
PRIMARY EXAMINER

1/6/2006